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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,527	12/08/2003	Junaid Ahmed Siddiqui	06354ZP USA	2963

23543 7590 09/21/2005

AIR PRODUCTS AND CHEMICALS, INC.
PATENT DEPARTMENT
7201 HAMILTON BOULEVARD
ALLENTOWN, PA 181951501

EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,527

Applicant(s)

SIDDIQUI, JUNAID AHMED

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9 and 11-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-9 and 11-16 are rejected under 35 U.S.C. 103(a) as obvious over Streinz et al. (686) in view of either (1) Smith et al. or (2) McCutcheon's Volume 1: Emulsifiers and Detergents (cited by applicants) for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claims 17-18 are rejected under 35 U.S.C. 103(a) as obvious over Streinz et al. (686) in view of either (1) Smith et al. or (2) McCutcheon's Volume 1: Emulsifiers and Detergents (cited by applicants). The combined references teach the claimed composition for similar reasons as are defined in the last office action with respect to claims 1-16 as rejected over these references.

Claims 1, 3-9 and 11-16 are rejected under 35 U.S.C. 103(a) as obvious over Misra et al. in view of either (1) Smith et al. or (2) McCutcheon's Volume 1: Emulsifiers and Detergents (cited by applicants) for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claims 17-18 are rejected under 35 U.S.C. 103(a) as obvious over Streinz et al. (686) in view of either (1) Smith et al. or (2) McCutcheon's Volume 1: Emulsifiers and Detergents (cited by applicants). The combined references teach the claimed composition for similar reasons as are defined in the last office action with respect to claims 1-16 as rejected over these references.

Applicant's arguments filed 7/5/05 have been fully considered but they are not persuasive.

Applicants argue that Streinz et al. does not teach the claimed surfactant (alkyne). The examiner acknowledges that the claimed specific surfactant is not literally disclosed and has made a combination rejection. **The primary reference specifically implies that no limitation is place on the surfactant (i.e. implies that any nonionic surfactant can be used).** With respect to the secondary references, applicants argue that there is no suggestion to combine the references since the references do not teach CMP composition (as indicated by the examiners) or **other types of polishing**. While the examiner has indicated that **CMP** compositions are not disclosed by the secondary references, Smith et al. teaches composition that can be used to clean substrates. Since this composition can contain an abrasive, it is the examiners position that this is a type of polishing composition, contrary to applicants position (i.e. the use of an abrasive in a cleaning composition will impart some polishing characteristics to the composition). In view of this, this reference is not outside the **general area** of polishing (although CMP compositions are not literally defined). The other secondary reference was merely used to show known non ionic surfactants. In view of the motivation, applicants argue that no motivation is apparent. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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In this case, the motivation is apparent in the primary reference when it is implied that **no** limitation is place on the nonionic surfactant. It is the examiners position that this broadly implies that **any** known nonionic surfactant, whether previously known for polishing or **not**, can be used and the secondary references clearly show that the claimed nonionic surfactant is known. This is apparent because the primary references **do not** state that the surfactants are limited to ones known for CMP compositions. In summary, the motivation for using this particle is defined by the primary references when it is implied that “**no particular restrictions are placed on the nonionic surfactant.** In addition, although not defined for CMP composition, the claimed surfactant is known to be used for polishing compositions, **in general** (see Smith et al.). Applicants have not clearly argued the examiners reasons for combining the reference defined in the last office action (no evidence of criticality is provided for the claimed surfactant).

Applicants argue that Misra et al. does not teach the claimed surfactant (alkyne). The examiner acknowledges that the claimed specific surfactant is not literally disclosed and has made a combination rejection. **The primary reference specifically implies that no limitation is place on the surfactant (i.e. implies that any nonionic surfactant can be used, as is known in the art).** The surfactant defined is a mere example and it is the examiners position that the reference is not only limited to the example defined (“a reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments” See *In re Van Marter*, 144 USPQ 421”). With respect to the secondary references, applicants argue that there is no suggestion to combine the references since the references do not teach CMP composition (as indicated by the examiners) or **other types of polishing.** While the examiner has indicated that **CMP** compositions are not disclosed by the secondary references, Smith et al.

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teaches composition that can be used to clean substrates. Since this composition can contain an abrasive, it is the examiners position that this is a type of polishing composition, contrary to applicants position (i.e. the use of an abrasive in a cleaning composition will impart some polishing characteristics to the composition). In view of this, this reference is not outside the **general area** of polishing (although CMP compositions are not literally defined). The other secondary reference was merely used to show known non ionic surfactants. In view of the motivation, applicants argue that no motivation is apparent. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is apparent in the primary reference when it is implied that **no** limitation is place on the nonionic surfactant, as long as it is known in the at.. It is the examiners position that this broadly implies that **any** known nonionic surfactant, can be used and the secondary references clearly show that the claimed nonionic surfactant is known to be used for polishing compositions, **in general** (see Smith et al.). Applicants have not clearly argued the examiners reasons for combining the reference defined in the last office action (no evidence of criticality is provided for the claimed surfactant). Assuming further arguendo about the specific surfactant exemplified by the primary reference, the examiner made an observation that "the substitution of on known SURFYNOL (nonionic) surfactant for another is well within the level of ordinary skill in the art". In addition, the primary reference teaches the use of SURFYNOL and this is of the nonionic type. In view of

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this, the use of any nonionic SURFYNOL surfactant is well within the level of ordinary skill in the art. Applicants have not clearly argued these observations. Finally, applicants state that the example of the surfactant according to the primary reference is not the same as the claimed surfactant (broad disclosure) because this is an ethoxylated diol and the claimed one is not. This is not a persuasive argument because applicants are arguing a limitation (non ethoxylated) not defined by the claims. Although the properties might be different, the independent claim, at least, does not exclude ethoxylated diol surfactants. The exemplified surfactant has two hydroxyl substituents thus reading on the claims

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548.

Evidence of unexpected results must be commensurate in scope with the subject matter

claimed. *In re Linder* 173 USPQ 356. Any evidence of synergism defined in the specification is not commensurate in scope with the new broad claim. In addition, the claimed invention does not show sufficient evidence of unexpected results of the claimed specific surfactant and fluoride/surfactant mixture.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

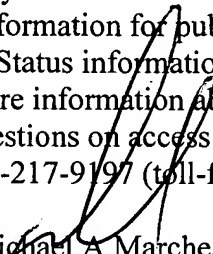
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/05

MM


Michael A Marcheschi
Primary Examiner
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